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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,965	04/11/2001	Ihor W. Tarnawskyj	D/A0895Q	3831

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EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 09/11/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/833,965

Applicant(s)

TARNAWSKYJ ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Drawings

1. ***This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.***

Specification

2. ***The disclosure is objected to because of the following informalities: On pages 1 and 2, the referenced U.S. applications are devoid of application nos. and filing dates.***

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. ***The following is a quotation of the second paragraph of 35 U.S.C. 112:***

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. ***Claims 1-15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***

A) The recited "carbon filler" per claim 1 constitutes indefinite subject matter as per the metes and bounds of such engender an indeterminacy in scope.

B) In claim 5, it is suggested that "a" be inserted before "fluorinated" at line 2 so as to engender claim language clarity.

C) The recited "said phenolic resin" per claim 6, "metal oxide fillers" per claim 12 and "polymeric fillers" per claim 13 engenders the non-express establishment of proper antecedent basis, i.e., "resin"/"resins" and "filler"/"fillers".

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D) The recited "phenolic resins" per claim 17 constitutes indefinite subject matter as per it not being readily ascertainable as to how many phenolic resins are intended for use in combination with the polyvinyl butyral resin.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-17 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hasegawa et al(U.S. 4,141,849), Caul et al(U.S. 4,588,419)Helland et al(U.S. 4,681,830), Ozawa et al(U.S. 5,030,515), Eadara et

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al(U.S. 5,169,890), Shaw-Klein et al(U.S. 5,620,765), Mammino et al(U.S. 6,067,430), Ninomiya et al(U.S. 6,391,959) or Lombardi et al(U.S. 6,437,034).

A) Hasegawa et al, as applied to claims 1-17, disclose and exemplify a developer comprising toner particles and finely divided graphite fluoride represented by the formula "(CF_x)_n and governed by a fluorine content falling within the scope of the claims wherein, the toner particles include a dye or pigment(carbon black) in a resin, as a binder which includes phenolic resin, epoxy resin, vinyl butyral resins etc. See, e.g., the Abstract, cols. 1-5, the Runs and claims of Hasegawa et al.

B) Caul et al, as applied to claims 1, 6 and 9-15, disclose and exemplify compositions defined basically as containing an epoxy/phenolic resin combination + carbon black. See, e.g., the Abstract, Runs 2 and 5 and the claims of Caul et al.

C) Helland et al, as applied to claims 1-6 and 9-16, disclose developer compositions defined basically as containing a thermoplastic binder such as Epoxy resins, polyvinyl butyral, etc., a magnetically responsive material, a fluorinated carbon material governed by a degree of fluorination of 10 to 100 wt.% and other additives such as carbon black, etc. See, e.g., the Abstract, cols. 1, 2, 4-6, Runs 1-3 and the claims of Helland et al.

D) Ozawa et al, as applied to claims 1 and 6-15, disclose and exemplify compositions defined basically as containing a phenolic resin, polyvinyl butyral and/or epoxy resin and carbon black. See Run 2.

E) Eadara et al, as applied to claims 1, 6 and 7-15, disclose and exemplify adhesive compositions defined basically as containing a phenolic resin, an epoxy resin and/or polyvinyl butyral and other adjuvants which include carbon black, graphite, etc. See, e.g., col. 6.

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- F) Shaw-Klein et al, as applied to claims 1, 6 and 9-15, disclose and exemplify adhesive compositions defined basically as containing a polyvinyl butyral and carbon black. See, e.g., the Abstract, cols. 4-5 and Run 9.**
- G) Mammino et al, as applied to claims 1-6 and 9-16, disclose and exemplify compositions defined basically as containing a fluorinated carbon filled epoxy polymer wherein the fluorinated carbon filler overlaps in scope with the claimed carbon filler. See, e.g., the Abstract, cols. 5-9 and 11-13 and the Runs. Mammino et al is provided by virtue of 35 USC 102(e).**
- H) Ninomiya et al, as applied to claims 1 and 6-15 and provided by virtue of 35 USC 102(e), disclose and exemplify adhesive compositions defined basically as containing a phenolic resin, a polyvinyl butyral, fine inorganic grains which include carbon black and other conventional additives. See, e.g., the Abstract, cols. 6-9 and TABLE 1, Run 4.**
- I) Lombardi et al, as applied to claims 1 and 6-15 and provided by virtue of 35 USC 102(e), disclose and exemplify adhesive compositions defined basically as containing at least polyvinyl butyral and/or a phenolic resin and an inert filler which includes graphite, and carbon black. See, e.g., the Abstract, col. 7, Runs V and VI and the claims.**

Each of patentees supra therefore anticipate the instantly claimed invention. The claimed property as an adhesive, if not expressly disclosed in the prior art supra, would be expected to be possessed by the compositions of each of patentees since the compositions of each of patentees are essentially the same as and made in essentially the same manner as the claimed adhesive. Applicant has the burden to show that this, in fact, is not the case as provided under the auspices of *In re Best et al*(195 USPQ 430).

Conclusion

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8. *The prior art made of record and not relied upon is considered to be of interest in teaching compositions similar to those as claimed and considered merely cumulative to the prior art supra.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR Jmr
September 9, 2002